

REMARKS

Examiner's Claim Rejections:

Examiner has rejected Claims 1-5 and 10-21 under 35 U.S.C. 103(a) as being unpatentable over Henley, Jr., in view of Sielaff, and Jonathan. The Office Action has further rejected Claims 6-9 under 35 U.S.C. 103(a) as being unpatentable over Henley, Jr., in view of Sielaff, and Jonathan. Applicant respectfully traverses the rejections. Applicant addresses Examiner's rejections of the Claims as follows:

Applicant's Current Claim Amendments:

Applicant has amended all Independent Claims to recite the patentable limitation that all raised grip pads and corresponding edges are parallel to one another. Applicant respectfully submits that none of the cited references teach or fairly suggest Applicant's invention, as now claimed. In fact, as further discussed below, any such combination of the references would not result in the invention as claimed, is taught away in at least one reference, and would result in the destruction of the intended purposes of all the references.

Establishing a Prima Facie Case of Obviousness:

To reiterate, Applicant notes that the burden of establishing a *prima facie* case of obviousness lies with the Patent Office. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) (stating: "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness"). To establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to combine the reference teachings; (2) there must be a reasonable expectation of

success; and (3) the prior art reference must teach or suggest all the claim limitations. See MPEP 2142-43.

Proposed Combination That Creates an Inoperable Reference Teaches Away From Combination:

It is well-settled that if the resulting combination creates an inoperable reference, then the combination is improper. In *Tec Air, Inc. v. Denso Manufacturing Michigan, Inc.*, 192 F.3d, 1353 (Fed. Cir. 1999), the invention was held to be nonobvious over the prior art because the proposed combination resulted in one of the patent references being inoperable for its intended purpose.

Impermissible Hindsight:

It is further well-settled that it is an improper use of hindsight to read Applicant's teachings into the prior art. In *In re Gibbons*, 100 USPQ 398, the court stated that "[i]n considering the question of invention, it is necessary to determine whether or not the art relied upon contains adequate directions for the practice of the invention *without resort to the involved application*. (emphasis added).

Examiner's Obviousness-Based Rejection of the Claims:

Examiner asserts that cited prior art references to Henley, Jr., Sielaff, and Jonathan teach or suggest Applicant's invention as originally claimed. However, as argued in the prior Office Action Response, Applicant respectfully asserts that the cited prior art references fail to teach or suggest all the claim limitations of Applicant's Claims, as amended, and that there is now no

suggestion or motivation to combine the reference teachings. As such, said cited prior art references do not establish a *prima facie* case of obviousness against the Claims as amended. Reconsideration is respectfully requested.

Specifically, Applicant asserts that cited prior-art reference to Henley, Jr. does not teach or fairly suggest Applicant's current amendments to all Independent Claims reciting the patentable limitation that Applicant's raised grip pads and corresponding edges are all arranged parallel to one another.

In actuality, Henley, Jr. discloses that the "[t]humb grip guide 11 is designed to cradle the thumb in the proper angle and provide the proper distance from the thumb to the tip of the pick 13. Finger grip guide 12 is designed to cradle the forefinger in the proper angle in relation to thumb grip guide 11 and to maintain the proper location of the pick 13 on the thumb....[t]he pick will be held between the thumb and forefinger with the thumb seated in thumb grip guide 11 and the forefinger seated in the finger grip guide 12. (See Henley, Jr., Col. 1, lines 43-52, and Col. 2, lines 1-2) As clearly illustrated in the drawings, specification and claims of Henley, the opposing faces of the instrument pick include channels that must be arranged transversely, or more specifically orthogonally (or perpendicular). This transverse arrangement is necessary for the thumb and forefinger to be placed in their correct position as explained quite explicitly in the specification. Therefore, Applicant asserts that not only does Henley teach away from Applicant's parallel arrangement of raised grip pads and edges, but that any change in Henley from this transverse arrangement would destroy the intended purposes of Henley, which as stated, is to place the forefinger and thumb in the proper transverse arrangement.

Furthermore, Applicant respectfully asserts that the Examiner has used impermissible hindsight to include the limitation into the proposed combination, that “each said at least one edge of each said raised grip pad is received by and interfaces with a user’s fingerprint grooves”. In fact, there is no teaching in any of the references that there are any edges to receive a fingerprint or thumb print. Applicant emphasizes that Henley teaches only transversely arranged channels to guide the *entire* finger and thumb into position, with no reference to the interface of the thumb print or finger print. More importantly, Henley does not teach an angled edge, but rather a peak on either side of the channels. Therefore, Henley’s peaks simply define the outer portions of the channels. In contrast, Applicant’s claimed edges are for interfacing directly with the finger print or thumb print.

Applicant respectfully asserts that the combination of the cited prior art references fails to teach or fairly suggest Applicant’s invention as recited in the amended Claims. Thus, it is respectfully submitted that all of the claim limitations of the amended claims are not disclosed by the cited prior art references and, as such, said cited prior art references do not establish a *prima facie* case of obviousness against said Claims as now amended. Applicant has also pointed out that Henley teaches away from Applicant’s invention as now amended. Any such change in Henley would destroy the intended purpose of Henley, which is to place the thumb and forefinger in the transverse arrangement. Finally, Applicant respectfully asserts that impermissible hindsight has improperly used Applicant’s invention as a basis for the obviousness rejections. Reconsideration is respectfully requested.

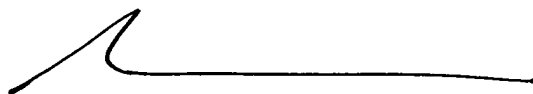
CONCLUSION

The above-made amendments are to form only and thus, no new matter was added. Applicant respectfully believes the above-made amendments now place the Claims and application in condition for allowance. This Response to Office Action is believed to be a full and complete response to the present Office Action. Should there be any questions or concerns, the Examiner is invited to telephone Applicant's undersigned attorney.

Dated: _____

1/18/2006

Respectfully submitted,



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